

Remarks

Applicants thank the Examiner for his careful consideration of this application.

Reconsideration of this application is now respectfully requested in view of the amendments above and the following remarks.

Claims 1-58 are now pending in the application, with Claims 1, 46, and 54 being the independent claims. Claims 54-58 were previously withdrawn.

At Page 2, the Office Action objects to the title of the invention. Applicants have submitted an amended title and request withdrawal of this objection.

Also at Page 2, the Office Action rejects Claims 3-13, 25, 40, 41, and 45-53 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. These rejections are respectfully traversed for at least the following reasons.

The Office Action asserts that Claims 40, 41, and 46 are not limited to tangible embodiments in that, unless qualified, the term, "computer-readable medium," includes allegedly "intangible embodiments (e.g., carrier waves)." While Applicants disagree with the assertion that carrier waves are intangible (it is respectfully submitted that carrier waves may be seen (e.g., on an oscilloscope), felt (e.g., a shock from an electrical line), and/or used), Applicants have opted to amend Claims 40, 41, and 46 to be limited to a "tangible computer-readable medium." It is respectfully requested, therefore, that the rejections of these claims on this basis, and of Claims 47-53, which depend from Claim 46, be withdrawn.

The Office Action further asserts that Claims 3-13, 25, 45, 50, and 53 contain unpatentable subject matter. The Office Action refers to "mental processes and abstract ideas" and discusses "[t]he process of approving by a human editor," so it is presumed that this is the basis for these rejections.

Applicants note, first, that *Claims 4-13 do not contain any such references, nor do they depend from any claims containing such references*. It is, therefore, respectfully submitted that *this rejection is irrelevant to Claims 4-13* and that they should not have been included in the list of claims rejected based on this rationale. Applicants respectfully request that this be addressed in any subsequent Office Action.

In view of the above, it is respectfully submitted that only Claims 3, 25, 45, 50, and 53 are at issue with respect to this rationale for rejection, and they will now be addressed.

Applicants respectfully submit that the Board of Patent Appeals and Interferences' (BPAI) recent decision in Ex parte Lundgren, BPAI, No. 2003-2088, 9/28/05, renders this rejection untenable. In particular, the Lundgren case was based on a patent application directed to a method for compensating a manager and did not include any disclosure or suggestion of any computer, automated means, or any other apparatus. The BPAI overturned the Examiner's rejection, which was based on an assertion that the claimed invention was an economic theory expressed as a mathematical algorithm, and thus "outside the technological arts." This decision, therefore, supports the idea that an algorithm performed by a human is within the realm of patentable subject matter.

Furthermore, a human editor is far from being a "disembodied concept," as asserted at Page 14 of the Office Action. A human editor may be viewed as a living, thinking editing apparatus. By analogy, if one were to declare any method that uses human interaction as non-statutory, the following are some examples of what would result and why such results are contradicted by practice:

- Surgical methods would be non-statutory, as they are always performed by a human on a human. It is clearly not the case that surgical methods are non-statutory, as there are many patents on surgical methods.
- Any apparatus or method that requires that a human operator to make an observation and to change a setting in a machine or process would be non-statutory. Again, this is clearly not the case in practice, as many patents include claims in which a human operator observes some parameter and changes a setting based on observations.

Based on these and other observations, Applicants respectfully submit that it cannot be true that a process or apparatus that requires a step of human intervention is automatically not within the realm of statutory subject matter. Stated differently, it is respectfully submitted that merely including the occurrence of human intervention in a claim does *not* render the claim non-statutory.

Additionally, Applicants restate their previous arguments with regard to Claims 50 and 53. In particular, it is noted that each of these claims is directed to a system. In particular, each claims cites further limitations to a system that the system includes a human-computer interface

and that a first filter (and in the case of Claim 50, at least one second filter) comprises a presentation via the human-computer interface and means for receiving input (from a human editor). These limitations are not directed to process at all; rather they are directed to components of a system (interface, presentation, and input means). For at least this reason, Claims 50 and 53 are directed to statutory subject matter, and the rejections of these claims should be withdrawn.

At Pages 3-4, the Office Action rejects Claims 3-13, 25, 45, 50, and 53 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully traverse these rejections for at least the following reasons.

First, the rationale given for these rejections is based on the use of human editing. As noted above, *Claims 4-13 do not contain any references to human editing, nor do they depend from any claims containing such references.* It is, therefore, respectfully submitted that *this rejection is irrelevant to Claims 4-13* and that they should not have been included in the list of claims rejected based on this rationale. Applicants respectfully request that this be addressed in any subsequent Office Action.

Claims 3, 25, 45, 50, and 53 do contain references to human editing. It is respectfully submitted that such human editing is described at least at Pages 3, 7, and 10-12 of Applicants' specification. Based upon these passages, Applicants fail to understand the Office Action's assertion of a lack of enablement. Should a subsequent Office Action maintain these rejections,

Applicants respectfully request a more complete explanation as to what is asserted as not being enabled.

At Page 4, the Office Action rejects Claims 1-53 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have amended Claims 1 and 46 to address the specific antecedent basis issues discussed at Page 4 of the Office Action and respectfully request that these rejections be withdrawn.

At Pages 5-14, the Office Action rejects Claims 1-53 under 35 U.S.C. § 102(e) as being anticipated by Legh-Smith et al. (U.S. Patent No. 6,178,419). These rejections are respectfully traversed for at least the following reasons.

The invention as claimed in Claim1 (as amended) is directed to: "A method of compiling and accessing subject-specific information, associated with a particular subject, from a computer network, the method comprising the steps of:

traversing links between sites on the computer network;

filtering contents of each site visited to determine relevancy of content to said subject; and

presenting for indexing information on each site deemed relevant by said filtering."

First, it is respectfully submitted that Legh-Smith et al. fails to teach or suggest "traversing links between sites on the computer network." The Office Action at Page 5 cites Legh-Smith et al. at col. 9, lines 23-67 and at col. 5, lines 31-44 as teaching this limitation.

However, review of the former passage of Legh-Smith et al. reveals that this passage describes a process of building a query for a search engine, sending the query to the search engine, and saving the results. In other words, ***there is no disclosure of traversing links between sites on a computer network in this passage.*** The latter passage contains similar disclosure. Therefore, it is respectfully submitted that the system of Legh-Smith et al. merely sends queries to search engines; it does not traverse links of a network.

Next, it is also submitted that Legh-Smith et al. fails to teach or suggest "filtering contents of each site visited to determine relevancy of content to said subject." The Office Action cites Legh-Smith et al. at col. 4, lines 47-67 and at col. 5, lines 1-27 as disclosing this limitation. A review of these passages reveals that they merely describe a system and process for building and populating a database. Namely, searches are built and sent to search engines, and the results are stored. ***Applicants are unable to locate any mention or description of any process that might be characterized as "filtering contents of each site visited to determine relevancy of content to said subject."*** Nor have Applicants been able to locate such filtering anywhere else in Legh-Smith et al.

Finally, it is respectfully submitted that Legh-Smith et al. fails to teach or suggest "presenting for indexing information on each site deemed relevant by said filtering." The Office Action cites Legh-Smith et al. at col. 1, lines 23-35 as teaching this limitation. However, while this passage does mention that "[a] large Internet search engine may have a stored index of many millions of pages," Applicants have found no mention here (or anywhere else in Legh-Smith et

al.) of "presenting for indexing information on each site deemed relevant by said filtering," as claimed.

For at least these reasons, it is respectfully submitted that Claim 1 is allowable over the cited prior art. Because Claims 2-45 depend, directly or indirectly, from Claim 1, it is further submitted that they, too, are allowable over the cited prior art.

The invention as claimed in Claim 46 (as amended) is directed to: "A system that compiles and permits accessing of subject-specific information, associated with a particular subject, from a computer network, the system comprising:

a host computer executing software from a tangible computer-readable medium, the software comprising:

a smart crawler for traversing the computer network;

a first filter, to filter out sites, based on site contents, whose contents are irrelevant to said subject, and to permit only relevant sites to pass; and

an indexer to index the relevant sites; and

memory, connected to the host computer, for storing indexed subject-specific information generated by said indexer."

First, Legh-Smith et al. fails to disclose "a smart crawler." The Office Action cites Legh-Smith et al. at col. 5, lines 36-44 and at col. 1, lines 23-35 as disclosing this limitation. However, Applicants note that these passages fail to teach the use of any "smart crawler." Applicants note, first, that the actual system of Legh-Smith et al. does not include *any* crawler(s); it merely builds

and sends queries to search engines and collects the results. Second, Applicants note that the specific search engines discussed in Legh-Smith et al. all use conventional crawlers, which, as discussed at Page 2, lines 9-17 of Applicants' specification, consider all information to be relevant. Applicants have defined the term, "smart crawler," at Page 10 of their specification, as including "additional features that differentiate" it from other crawlers. Hence, these conventional crawlers, which are not part of the system of Legh-Smith et al., still fail to disclose a smart crawler, as claimed.

Next, Legh-Smith et al. fails to disclose "a first filter, to filter out sites, based on site contents, whose contents are irrelevant to said subject, and to permit only relevant sites to pass." The Office Action cites Legh-Smith et al. at col. 5, lines 45-60 as disclosing such a filter. However, while this passage describes a form of filtering, it fails to describe the claimed filter, which is based on *relevance to the subject that is being targeted*. Second, the filtering in this passage is based on URLs rather than on sites' contents, as claimed.

For at least these reasons, it is respectfully submitted that Claim 46 is allowable over the cited prior art. Because Claims 47-53 depend, directly or indirectly, from Claim 46, it is further submitted that they, too, are allowable over the cited prior art, for at least the same reasons.

While Applicants do not necessarily concur with the Office Action's characterizations of the claims and/or the references with regard to other claimed features, Applicants choose not to discuss each such feature. Consequently, the lack of explicit discussion is not to be understood as indicating tacit agreement with such characterizations.

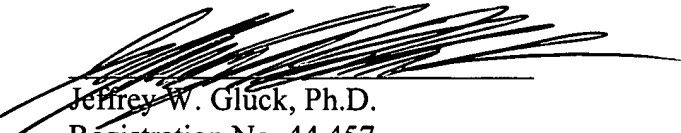
Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants, therefore, respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

Date: December 6, 2005



Jeffrey W. Gluck, Ph.D.
Registration No. 44,457
VENABLE LLP
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4000
Direct Dial: (202) 344-8017
Telefax: (202) 344-8300